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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,246	02/26/2002	Bruce H. Hanson	SWIM-018/00US	3482

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EXAMINER
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JOHNSON, JERROLD D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,246

Applicant(s)

HANSON ET AL.

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 6-11, 15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of the election of species requirement in the reply filed on 16 January 2004 is acknowledged. The traversal is on the ground(s) that there is not burden, and that the searches would be the same. This is not found persuasive for the very simple reason that the locations where an L shaped (2 sided) receptacle will be classified will not necessarily include each and every location where a C shaped (3 sided) receptacle will be classified. Applicants assertion to the contrary is noted, but is deemed un-persuasive. Additionally, Applicant is reminded of the following recitation from the MPEP:

#### **808.01(a) Species**

Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. See MPEP § 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification.

A single disclosed species must be elected as a prerequisite to applying the provisions of 37 CFR 1.141 to additional species if a generic claim is allowed.

Even if the examiner rejects the generic claims, and even if the applicant cancels the same and admits that the genus is unpatentable, where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second binding member must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities: Page 6 line 27 "to fold" has been erroneously repeated. Page 7, line 9, 112 does not refer to a second binding member, but instead refers to a product within the stack.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5,12,14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In these claims it is unclear if the Applicant is claiming the combination of the package and a product, as the relationship of the size of the product to the package is being set forth. However, no combination has been positively set forth. Accordingly, the claims have been interpreted as being drawn not to the combination. Applicant should amend the claims to claim the positively set forth the product in the combination if that is what is desired. Conversely, if the Applicant is claiming the package only, then recitations such as "each width of the first and second constraining walls is at least equal to the bound edge and the non bound edge of the product stacked thereon" would

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be better served by recitations such as "each width of the first and second constraining walls is at least equal to the bound edge and the non bound edge of the product for which the package is adapted to have stacked thereon".

With respect to claims 12 and 16, claim 12 recites the first binding member extending "between the length ...", claim 16 recites the first binding member extends "along the length ...". These expressions are confusing, and may be contradictory.

Correction is required.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,2,4,5,12,14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by McDonald US 1,286,374.

McDonald discloses a flat mail sleeve packaging system suitable for the intended use to stack product with bound edges in a constrained homogenous mass, comprising: a first constraining wall A having a first constraining surface; and a second constraining wall B having a second constraining surface, the second constraining wall being positioned with respect to the first constraining wall at a substantially perpendicular angle thereto, wherein the first and second constraining walls are adapted for having the product placed therebetween with the bottom edges of the product all facing in a same direction without collapsing.

Note that although McDonald does not specifically show stacked product having bound edges, his flat mail sleeve packaging system is inherently capable of having the product placed therebetween with the bottom edges of the product all facing in a same direction without collapsing. Bound product of a size which would fit within the sleeve of McDonald are well known.

Re claim 2, the sleeve further comprises a first binding member E extending between a length of one of the first and second constraining walls.

Re claim 4, the first and second constraining walls form a corner therebetween that is adapted to conform to a corner of the product.

Re claim 5, the combination of the sleeve and a bound product has not been set forth (see 112 2<sup>nd</sup> paragraph rejection above). The claim is interpreted as further defining the intended use of the sleeve. Additionally, bound products of a size which would fit within the sleeve of McDonald are well known. And, McDonald is inherently capable of having such a bound product stacked thereon such that "a width of the first and second constraining walls is at least equal to a bound edge and the non bound edge of the product stacked thereon.

Re claim 12, here again the combination of the sleeve and a bound product has not been set forth (see 112 2<sup>nd</sup> paragraph rejection above). Bound products of a size which would fit within the sleeve of McDonald are well known. And, McDonald is inherently capable of having such a bound product stacked thereon such that "each width of the first and second constraining walls is at least equal to the bound edge and the non bound edge of the product stacked thereon, the first and second constraining

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walls are adapted for having the product placed therebetween with the bound edges of the product all facing in a same direction.”

Re claim 14, see the rejection of claim 12. McDonald is inherently capable of having such a bound product stacked thereon such that “the width of the first and second constraining walls is larger than the bound edge and the non bound edge of the product stacked thereon.” Or in other words, there are many examples of bound product which would fit within these size constraints with respect to the sleeve of McDonald.

Re claim 16, the first binding member E extends along the length of the second constraining wall B.

### ***Claim Rejections - 35 USC § 103***

Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Jacobsmeyer US D415,730.

McDonald does not disclose a second binding member.

Jacobsmeyer discloses in Figs. 9 and 10 the use of perpendicular first and second straps.

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the sleeve of McDonald to include a second strap as taught by Jacobsmeyer so as to provide additional stability to a stack of the product, particularly



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during times that the sleeve is in transit, so as to prevent the product from falling from the sleeve.

Jacobsmeier does not show the stacked product in the same orientation as claimed with respect to the sleeve, but does indeed show that the size of the sleeve first and second sides is greater than the corresponding dimensions of the product.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

McClain US 3,885,668 discloses stacked product within a two sided sleeve.

Schade US 3,592,344 discloses bound product within a two sided sleeve.

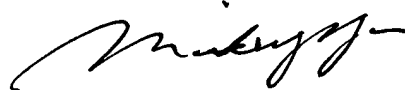
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ

A handwritten signature in black ink, appearing to read 'Mickey Yu', with a stylized flourish at the end.

Mickey Yu  
Supervisory Patent Examiner  
Group 3700